

CERTIFICATE OF TRANSMISSION/MAILING

Ref No. 12439-0190

I hereby certify that this correspondence is being facsimile transmitted to the USPTO at (571) 273-0025 or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 April 20, 2006.

Erin Cowles

FAX RECEIVED

APR 20 2006

OFFICE OF PETITIONS**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/035,633
Applicant : Eldridge et al.
Filed : December 28, 2001
TC/A.U. : 3729
Examiner : Carl J. Arbcs

Confirmation No. 6089

Docket No. : P3C1-US

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.313(c) TO WITHDRAW FROM ISSUE**To Whom It May Concern:**

Applicants respectfully petition the Director under 37 C.F.R. § 1.313(c) that the above-identified patent application be withdrawn from issue to consider Applicants' Request For Continued Examination of the application. (See 37 C.F.R. § 1.313(c)(2).) A Request For Continued Examination (RCE) in compliance with 37 C.F.R. § 1.114 is submitted herewith. The RCE includes an Information Disclosure Statement ("IDS") citing the following four Japanese patent documents, which were first cited by the Japanese Patent Office in an action dated March 16, 2006 in a counterpart Japanese patent application: (1) JP 61-49432, (2) JP 02-250327, (3) JP 63-136657, and (4) JP 02-109339. The IDS also cites U.S. Patent No. 4,784,972, which is a U.S. counterpart to JP 02-109339.

Applicants paid the issue fee in the above-identified patent application on February 28, 2006. (A copy of the issue fee payment record, which was received at the Patent and Trademark Office on March 3, 2006, is attached as Exhibit A.) The four Japanese patent documents cited in the IDS were first identified to Applicants in a letter dated April 4, 2006 from a Japanese law firm, and Applicants thereafter discovered the U.S. patent cited in the IDS. (A copy of the April 4, 2006 letter is attached as Exhibit B.) Applicants believe that the five references cited in the

04/24/2006 CKHLOK 00000011 10035633

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Appl. No. 10/035,633
Petition dated April 20, 2006

IDS should be reviewed and considered by the Examiner in charge of the above-identified application before the application issues as a patent. Applicants believe that allowing the Examiner to consider those references constitutes good and sufficient reason for withdrawing the application from issue.

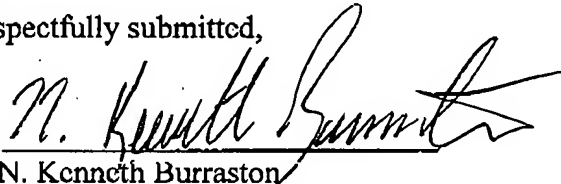
For the reasons discussed above, Applicants respectfully request that the above-identified patent application be withdrawn from issue and prosecution reopened in accordance with the RCE submitted herewith to allow the Examiner to consider the four Japanese patent documents cited by the Japanese Patent Office and a corresponding U.S. patent document.

Applicants submit herewith a Credit Card Payment form providing payment for a petition fee of \$130.00 as set forth in C.F.R. 17(h) and an RCE fee of \$790.00. In addition, Applicants authorize the Director to charge any additional fee or any deficiency in the fees provided for as needed for acceptance of this paper to Deposit Account No. 50-0843 (order no. 12439-0190).

Respectfully submitted,

Date: April 20, 2006

By


N. Kenneth Burraston
Reg. No. 39,923

Kirton & McConkie
1800 Eagle Gate Tower
60 East South Temple
P.O. Box 45120
Salt Lake City, Utah 84111-1004
Telephone: (801) 323-5934
Fax: (801) 321-4893

EXHIBIT A

Complete and send this form, together with applicable fee(s), to: **Mail**

Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
(571) 273-2885

or **Fax**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated and directed below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

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7590

11/30/2005

N. KENNETH BURRASTON
KIRTON & MCCONKIE
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450

FormFactor, Inc.
Legal Department
7005 Southfront Road
Livermore, Ca 94551

Certificate of Mailing or Transmission
 I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

Vanessa G. Latte (Depositor's name)
 (Signature)
 February 28, 2006 (Date)

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 10/035,633 | 12/28/2001 | Benjamin Nilcs Eldridge | P3C1-US | 6089 |

TITLE OF INVENTION: RESILIENT CONTACT STRUCTURES FORMED AND THEN ATTACHED TO A SUBSTRATE

| APPLN. TYPE | SMALL ENTITY | ISSUE FEE | PUBLICATION FEE | TOTAL FEE(S) DUE | DATE DUE |
|----------------|--------------|-----------|-----------------|------------------|------------|
| nonprovisional | NO | \$1400 | \$300 | \$1700 | 02/28/2006 |

| EXAMINER | ART UNIT | CLASS-SUBCLASS |
|---------------|----------|----------------|
| ARBES, CARL J | 3729 | 029-884000 |

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.563).

- ☒ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list:

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively,
 (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

N. Kenneth Burraston

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

FormFactor, Inc.

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Livermore, Ca

03/06/2006 SDENB02 00000045 500285 10035633
 02 FC:1504 1400.00 BR
 03 FC:8001 300.00 BR
 6.00 BR

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. The following fee(s) are enclosed:

- ☒ Issue Fee
☒ Publication Fee (No small entity discount permitted)
☒ Advance Order - # of Copies **2**

4b. Payment of Fee(s):

- ☐ A check in the amount of the fee(s) is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☒ The Director is hereby authorized to charge the required fee(s), or credit any overpayment, to Deposit Account Number **50-0285** (enclose an extra copy of this form):

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.
 NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature

Stuart L. Merkadeau

Date **February 28, 2006**

Typed or printed name

Stuart L. Merkadeau

Registration No. **33,262**

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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EXHIBIT B

TMI Associates
International Legal Services
23rd Floor, Roppongi Hills Mori Tower
6-10-1 Roppongi, Minato-ku
Tokyo 106-8123, Japan



Tel. +81-(0)3-6438-5511 (Main)
+81-(0)3-6438-5511 (Patent & Trademarks)
Fax. +81-(0)3-6438-5522 (Main)
+81-(0)3-6438-5523 (Patent & Trademarks)
<http://www.tmi.gr.jp/>

VIA FACSIMILE AND COURIER

April 4, 2006

Stuart L. Merkadeau, Esq.
FORMFACTOR, INC.
Legal Department
7005 South Front Road
Livermore, CA 94551
U.S.A.

RECEIVED

APR 04 2006

Re: Applicant: FormFactor, Inc.
Japanese Patent Application No. 2000-202978
Your Ref: P3-D1-JP
Our Ref: F0250 RP06JP/KOS

Dear Mr. Merkadeau:

We have received an Office Action from the Japan Patent Office regarding the above-referenced application. Enclosed are a copy of the Office Action, its English translation, a copy of the Patent Publications cited, and a copy of English abstract for the cited Japanese Patent Publication.

The term to respond to this Office Action expires on

June 16, 2006.

This date can be extended for three months by request.

We would appreciate it if you could provide us with your instructions by June 9, 2006 our time, to allow us time to prepare the arguments and amendments.

Please be informed that we are also allowed to file a divisional application during this period, namely by June 16, 2006. Therefore, if the applicant wishes to file any divisional applications, please provide us with your instructions by June 9, 2006.

If you need our detailed comments, please do not hesitate to contact us.

Very truly yours,

Yoshiyuki Inaba

YI/KOS/mis
Encls.

(Translation)

Reference No.: 500YY026

Mailing No.: 108782 Mailing Date: March 16, 2006

NOTICE OF REASONS FOR REFUSAL

Patent Application No.: 2000-202978
Drafting Date: March 14, 2006
JPO Examiner: Masaaki Sakamoto 8265 4R00
Attorneys for Applicant: Yoshiyuki Inaba (and two others)
Applicable Provisions: Sections 17^{bis}(iii), 29(2), 36, 37

It has been found that the present patent application should be refused for the reasons stated below. If the Applicant has any argument against this Notice, such argument should be filed within three months from the mailing date above.

Reasons

1. The amendment dated November 13, 2002 has not been made within the scope of matter described in the specification or drawings originally attached to the request, regarding the following points. Accordingly, it does not fulfill the requirements set forth in Section 17^{bis}(iii) of the Patent Law.

Notes

The content of the post-amendment claims is not clearly described in the specification or drawings originally attached to the request, nor is it matter obvious from the matter described in the same.

(An amendment made within the scope of matter described in the

original specification should be validated by pointing out not paragraphs, but specific sentences in the part in the description of the original specification that is the grounds for the amendment, and explaining the correspondence.)

2. The invention according to the below claims in the present application could have easily been made prior to the filing of the application by any person having common knowledge in the technical field to which the invention pertains, based on inventions described in publications distributed in Japan or overseas or made available to the public through communication media prior to the filing of the application. Accordingly, it is unpatentable under the provisions of Section 29(2) of the Patent Law.

Notes (Including the List of Cited References)

- Claims 1-9
- Cited References 1-4
- Remarks

Cited Reference 1 discloses an electronic assembly connected to a print circuit board by a cushioned (corresponding to "recoverable" in the invention in the present application) contact structure. The structure of carrying a plurality of semiconductor dies is commonly used (for example, see Cited Reference 2). In the electronic assembly disclosed in Cited Reference 1, too, carrying a plurality of semiconductor dies could be done arbitrarily by any person skilled in the art. Providing a wire with a protection layer (Claim 6) and forming a contact structure on a sacrifice substrate (Claim 7) are described respectively in Cited References 3 and 4.

3. The description in the specification and drawings in the present application does not fulfill the requirements set forth in Section 36(4) of the Patent Law regarding the following points.

Notes

The detailed description of the invention in the present application does not include a clear and sufficient description with which any person skilled in the art can implement the invention according to Claims 1-9.

(Only the embodiment of the invention according to the claims in the present application should be described as the embodiment of the invention; other embodiments should be described as reference examples.)

4. The present application does not fulfill the requirements set forth in Section 37 in the Patent Law.

Notes

(1) Although the product invention according to Claim 1 and that according to Claims 10-12 share the same problem to be solved, they do not share the main feature of the content essential for the configuration.

(2) The product invention according to Claim 1 is not a machine, device, or apparatus directly used for conducting a method invention according to Claims 13-29.

Moreover, the invention according to Claims 13-29 is not a method for producing, using, or treating a product invention according to Claim 1.

Because the present application does not comply with Section 37 of the Patent Law, no examination has been conducted on the invention according to the claims other than Claims 1-9.

Note that the inventions according to Claims 10, 11, 12, 13, 14-23 and 25-28, 24-28, and 29 do not fulfill the requirements for unity.

List of Cited References

1. Japanese Patent Laid-Open Publication No. 2-250327, official gazette
 2. Japanese Patent Laid-Open Publication No. 63-136657, official gazette
 3. Japanese Patent Laid-Open Publication No. 2-109339, official gazette
 4. Japanese Patent Laid-Open Publication No. 61-49432, official gazette
-

Record of Prior Art Reference Search Results

- Technical Field Searched IPC
H01L 21/80
H01L 25/00 - 25/18

This Record does not constitute a reason for refusal.

Inquiries concerning the content of this Notice:

Masaaki Sakamoto, Examiner

at

Electronic Material Manufacturing Division

/ Third Patent Examination Department

TEL: 03-3581-1101 EX: 3470



TMI Associates 23rd Floor, Roppongi Hills Mori Tower 6-10-1 Roppongi, Minato-ku, Tokyo 106-6123, Japan

Tel: +81-3-6438-5511 Fax: +81-3-6438-5522

FAX MESSAGE OF 6 PAGE(S) INCLUDING THIS COVER

To: Stuart L. Merkadeau
FormFactor Inc.

Fax No: 925-290-4119

From: Yoshiyuki Inaba (yinaba@tmi.gr.jp)

Sent By: Kaori Osaki

Date: April 4, 2006

URL: <http://www.tmi.gr.jp/>

Original: ☒ To follow via mail ☐ To follow via courier ☐ Original will not follow

This fax is confidential and may also be privileged. It is intended only for the use of the named recipient. If you are not the intended recipient, please notify the sender by telephone immediately and then return it by mail to the address shown above. You should not copy the fax or use it for any purpose nor disclose its contents to any person.

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***** MESSAGE *****

Re: Applicant: FormFactor, Inc.
Japanese Patent Application No. 2000-202978
Your Ref: P3-D1-JP
Our Ref: F0250 RP06JP/K06

Please see the attached.

CANCELLED
APR 19 2006
OFFICE OF PETITIONS

N. Kenneth Burraston

KIRTON & McCONKIE

TELEPHONE (801) 328-3600
FACSIMILE (801) 321-4893

A PROFESSIONAL CORPORATION
1800 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
P.O. BOX 45120
SALT LAKE CITY, UTAH 84145-0120

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APR 20 2006

OFFICE OF PETITIONS

FACSIMILE TRANSMISSION SHEET

DATE: April 20, 2006

BILLING #: 12439.190

TO: Office of Petition
US Patent & Trademark Office

FAX #: (571) 273-0025

FROM: N. Kenneth Burraston

53 NUMBER OF PAGES INCLUDING COVER SHEET

COMMENTS: Transmitted herewith is: **URGENT: Petition to Withdraw from Issue under 37 CFR§1.313(c)**, an Information Disclosure Statement, Request for Continued Examination, Fee Transmittal, Credit Card Payment Form, for:

App. No.: 10/035,633

Confirmation No.: 6089

Applicant: Eldridge et al.

Filed: December 28, 2001

TC/A.U.: 3729

Examiner: Carl J. Arbes

Docket No.: P3C1-US

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PTO/SB/21 (09-04)

Approved for use through 07/31/2008. OMB 0851-0031

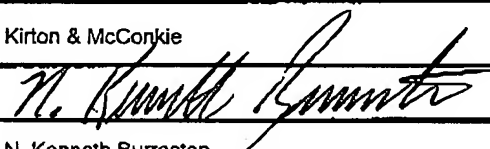
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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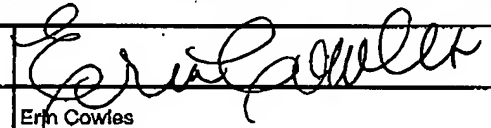
| | | | |
|---|------------------------|-------------------|---|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/035,633 | FAX RECEIVED APR 19 2006 OFFICE OF PETITIONS |
| | Filing Date | December 28, 2001 | |
| | First Named Inventor | Eldridge et al | |
| | Art Unit | 3729 | |
| | Examiner Name | Carl J. Arbes | |
| Total Number of Pages in This Submission | Attorney Docket Number | P3C1-US | OFFICE OF PETITIONS |

| ENCLOSURES (Check all that apply) | | |
|---|---|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Request For Continued Examination |
| Remarks | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|---|----------|--------|
| Firm Name | Kirtan & McConkie | | |
| Signature |  | | |
| Printed name | N. Kenneth Burraston | | |
| Date | April 20, 2006 | Reg. No. | 39,923 |

CERTIFICATE OF TRANSMISSION/MAILING

| | | | |
|---|---|------|----------------|
| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: | | | |
| Signature |  | | |
| Typed or printed name | Erin Cowles | Date | April 20, 2006 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

CERTIFICATE OF TRANSMISSION/MAILING

Ref. No.: 12439-0190

I hereby certify that this correspondence is being facsimile transmitted to the USPTO at (571) 273-0025 or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 20, 2006.


 Kim Cowles
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APR 20 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**OFFICE OF PETITIONS**

Appl. No. : 10/035,633
 Applicant : Eldridge et al.
 Filed : December 28, 2001
 TC/A.U. : 3729
 Examiner : Carl J. Arbes

Confirmation No. 00000000

FAX RECEIVED

APR 19 2006

OFFICE OF PETITIONS

Docket No. : P3C1-US

Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

FEE TRANSMITTAL

To Whom It May Concern:

1. Total Fee Paid: \$920.00**2. Method of Payment:**

☐ Check ☒ Credit Card ☐ Money Order ☐ Other ☐ None
☐ Deposit Account

Account Number 500843
 Account Name Kirton & McConkie

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit overpayments
☒ Charge any additional fee(s) or any underpayment of fee(s)
 to the above-identified deposit account.

3. Fee For Extra Claims:

| Extra Claims | | | | | Fee/Claim | | Fee Paid |
|---------------------------|-----|-------|---|---|-----------|-----|----------|
| Total Claims | n/a | - 20 | = | 0 | x | 50 | = 0 |
| Indp. Claims | n/a | - 3** | = | 0 | x | 200 | = 0 |
| Multiple Dependent Claims | | | | | x | 360 | = 0 |

* 20 or highest number of total claims previously paid for.

** 3 or highest number of independent claims previously paid for

Appl. No. 10/035,633
Fcc Transmittal dated April 20. 2006

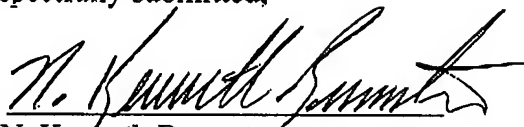
4. Additional Fees:

| Fee Description | Fcc Paid |
|---|--------------|
| Surcharge – late filing fcc or oath (\$130) | |
| Extension of one month (\$120) | |
| Extension of two months (\$450) | |
| Extension of three months (\$1020) | |
| Extension of four months (\$1590) | |
| Extension of five months (\$2160) | |
| Notice of Appeal (\$500) | |
| Filing appeal brief (\$500) | |
| Request for oral hearing (\$1000) | |
| Submission of IDS (\$180) | |
| Record patent assignment (\$40) | |
| RCE (\$790) | \$790 |
| Fee for Terminal Disclaimer (\$130) | |
| Fee for extra claims (from above): | |
| Other: Pctition fee (37 CFR 1.17(h)) | \$130 |
| Total: | \$920 |

Respectfully submitted,

Date: April 20, 2006

By


N. Kenneth Burraston
Reg. No. 39,923

Kirton & McConkie
1800 Eagle Gate Tower
60 East South Temple
P.O. Box 45120
Salt Lake City, Utah 84111-1004
Telephone: (801) 323-5934
Fax: (801) 321-4893